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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,916	10/01/2003	Adam Gronowski	PO-7945/PS-1132	8286

34947 7590 07/13/2005

LANXESS CORPORATION  
111 RIDC PARK WEST DRIVE  
PITTSBURGH, PA 15275-1112

EXAMINER
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ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/676,916

Applicant(s)

GRONOWSKI ET AL.

Examiner

Olga Asinovsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 06/08/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 10/436,616 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Transitional After Final Practice***

Upon reconsideration of the finality of the rejection of the last Office action mailed on 03/30/2005, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

2. Claims 1-2 and 4-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Gronowski et al Pub. No. US 2004/0006184 A1 (US Application No. 10/436,616).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Gronowski discloses an elastomeric polymer containing repeating units derived from at least one C4 to C7 isomonoolefin monomer, [0021]; at least one C4 to C14

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multiolefin monomer, [0013]; at least one multiolefin cross-linking agent, [0026]; a chain transfer agent, [0028]; at least one filler, [0041]; and at least one peroxide curing system [0053]. The polymer comprises less than 15 wt.% of solid matter insoluble in boiling cyclohexane under reflux for 60 min., [022]. The most preferably the monomer mixture comprises a C4 to C14 multiolefin in the amount of from 1% to 5% by weight [0029]. The chemical formula for preferred multiolefin monomers and multiolefin cross-linking agents overlap, [0027]. Reference discloses a process for producing a rubber composition, [0056]. A molecular weight of at least 20,000 g/mol is inherent to the resulting polymer being in a solid shaped article, [0057]. Although the additional C4 to C14 multiolefin monomer of the reference is not claimed in the present claims, the reference does teach the elastomeric polymer having less than 15 wt.% of solid matter insoluble in boiling cyclohexane under reflux for 60 min., [0022]. This characteristic for the elastomeric polymer in reference is the same that for the elastomeric polymer in the present claims. Thus, the presence of a C4 to C14 multiolefin monomer in the amount of up to 5 wt% has no effect on the properties of the obtained elastomeric polymer.

In light of the above, it is clear that the elastomeric polymer in the Pub No. 2004/0006184 anticipates the presently cited claims.

The Declaration of Mr. Gronowski under 37 CFR 1.131(a) filed on 06/08/2005 is not persuasive to overcome the rejection of the present claims under 102(e) since the anticipating is.

***Claim Rejections - 35 USC § 112***

3. Claims 1 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

An average molecular weight "Mn" is confusing because "Mn" is a number average molecular weight. An average molecular weight should be Mw.

In light of the new rejection, this action is not final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.A

July 05, 2005

Olga Asinovsky  
Examiner  
Art Unit 1711



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700